

## **REMARKS**

### **I. Introduction**

Claims 1 to 33 are pending in the present application. It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 11 to 33 Under 35 U.S.C. § 112, Second Paragraph**

Claims 11 to 33 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action alleges that it is unclear whether Applicants intend to limit the nonwoven to having both fibers of 6-15 dtex and fibers of 1-5 dtex. Applicants respectfully submit that claims, as amended, fully comply with the requirements of 35 U.S.C. § 112. Withdrawal of this rejection is therefore respectfully requested.

### **III. Rejection of Claims 11 to 33 Under 35 U.S.C. § 112, Second Paragraph**

Claims 11 to 33 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully submit that claims 11 to 33 fully satisfy the requirements of 35 U.S.C. § 112 for the following reasons.

The second paragraph of 35 U.S.C. § 112 merely requires that the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. As provided in M.P.E.P. § 2173.02, the “focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirement of clarity and precision.” In this regard, the “essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” *Id.* (emphasis added). “Definiteness of claim language must be analyzed, not in a vacuum, but in light of[, inter alia, the] content of the particular application disclosure[ and the] claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” *Id.* If the claims, when read in light of the Specification, reasonably apprise those skilled in the art both of the

utilization and scope of the invention, and if the language is as precise as the subject matter permits, the second paragraph of 35 U.S.C. § 112 demands no more.

M.P.E.P. § 2173.05(a) (citing Shatterproof Glass Corp. v. Libbey Owens Ford Co., 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985)).

The Office Action alleges that it is unclear why a nonwoven that is merely needled, as opposed to water jet bonded, requires a drying step. Claim 11, as amended, is limited to fibers between one and five dtex and requires water jet bonding. Applicants respectfully submit that claims, as amended, fully comply with the requirements of 35 U.S.C. § 112.

The Office Action further alleges that the term "thermosetting" in claim 11 is not clear. Applicants respectfully submit that the term "thermosetting" is reasonably clear to one of ordinary skill in the art. In this regard, the Examiner's attention is directed to the Specification, for example, p. 5, lines 19 to 28. Withdrawal of this rejection is therefore respectfully requested.

Regarding claims 21 to 24, 26, 27, 30 and 31, the Office Action alleges that the phrase "and a 5% modulus value in the machine direction of [x] N/5 cm, but at least [y] N/gm<sup>2</sup>" is indefinite for "claiming a first value, then a preferred value, wherein said values have different units." Applicants respectfully submit that the language "a 5% modulus value in the machine direction > 60 N/5 cm, but at least 0.6 Nm<sup>2</sup>/g" does not recite a preferred value for the 5% modulus. One skilled in the art would understand that the modulus values are specified in two dimensions, which are customary for this value. In this context, the standardization is first performed in accordance with the measuring strips inserted in the testing apparatus, or as a function of mass per unit area.

In light of the foregoing amendments and arguments, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 rejection and allowance of claims 11 to 33.

#### **IV. Rejection of Claims 11 to 33 Under 35 U.S.C. § 112, First Paragraph**

Claims 11 to 33 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the Specification in such as way as to enable one skilled in the art to make and/or use the invention. In particular, the Examiner stated that the Specification "does not disclose how to make the invention

as claimed (i.e., bonding fibers of a *first titer in a portion* of a spunbonded nonwoven by needling and bonding fibers of a *second titer in a second portion* with water jets and/or needling)." As indicated above, claim 11, as amended, is limited to fibers having 1-5 dtex and no longer recites the language "in a portion." Therefore, Applicants respectfully submit that the present claims fully satisfy the requirements of 35 U.S.C. § 112. Withdrawal of this rejection is therefore respectfully requested.

**V. Rejection of Claims 11 to 33 Under 35 U.S.C. § 103(a)**

Claims 11 to 33 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of JP 10-273873, DE 29 00 888 and EP 13355. Applicants respectfully submit that claims 11 to 33 are patentable over the cited references for the following reasons.

JP 10-273873 relates to a base fabric for a tufted carpet. JP 10-273873 states that the continuous fibers are interlace with one another by needle punching. Abstract. The English abstract of JP 10-273873 does not disclose, or even suggest, bonding fibers or filaments having a titer of 1 to 5 dtex in the spunbonded nonwoven by using one of water jets and a combination of water jets and needling, as required by claim 11. DE 29 00 888 and EP 13355 are not relied upon for disclosing or suggesting the features recited in claim 11 not disclosed or suggested by the combination of JP 10-273873, DE 29 00 888 and EP 13355. Indeed, DE 29 00 888 and EP 13355 does not disclose, or even suggest, the features recited in claim 11 not disclosed by the combination of JP 10-273873, DE 29 00 888 and EP 13355.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d

981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, the combination of JP 10-273873, DE 29 00 888 and EP 13355 does not disclose, or even suggest, all of the limitations of claim 11. Therefore, the combination of JP 10-273873, DE 29 00 888 and EP 13355 does not render obvious claim 11. Withdrawal of this rejection is therefore respectfully requested.

Claims 12 to 33 ultimately depend from claim 11 and therefore include all of the limitations of claim 11. As more fully set forth above, it is respectfully submitted that the combination of JP 10-273873, DE 29 00 888 and EP 13355 does not disclose, or even suggest, all of the limitations of claim 11, from which claims 12 to 33 depend. Therefore, it is respectfully submitted that the combination of JP 10-273873, DE 29 00 888 and EP 13355 does not render unpatentable these dependent claims for at least the same reasons provided above in support of the patentability of claim 11. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

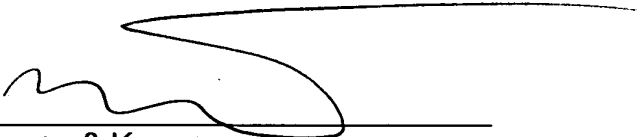
In regard to claims 14 and 15, the Office Action alleges that it is well known in the art that calendaring a fabric is a conventional finishing step. Further, in regard to claims 16 to 20, the Office Action alleges that embossing is a well known method of bonding nonwovens and/or creating a textured surface of a nonwoven. Applicants respectfully traverse these contentions to the extent that they are maintained and requests that the Examiner provide specific evidence to establish those assertions and/or contentions under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because this rejection is apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also M.P.E.P. § 2144.03).

**VI. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Dated: October 4, 2005

  
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